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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,596	01/30/2001	Mark R. Bennett	END9-2000-0188US1	2376

23550 7590 12/31/2003

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ALBANY, NY 12207

EXAMINER
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THOMPSON JR, FOREST

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/772,596

Applicant(s)

BENNETT ET AL.

Examiner

Forest Thompson Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. Claims 1-30 have been examined.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 9-15, 18-20, 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Barnes et al. (U.S. Patent No. 5,970,475).

**Claims 1-6, 9-15, 18-20, 23-28:** Barnes et al. discloses aspects of applicant's invention of a system for exchanging information related to a business management process. Applicant's invention relates to a system and method for exchanging automotive information between at least two automotive trading partners engaged in an automotive transaction. Examiner asserts that prior art that discloses a business process that incorporates similar functionality as applicant's claimed invention is compatible prior art. For example, Barnes et al. is classed as 705/26 art (the same as applicant's instant invention), discloses similar business functionality, and, therefore, is compatible prior art.

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Barnes et al. discloses a electronic commerce system and method procuring goods/services by any one of a plurality of users within a customer organization from a supplier. To enable suppliers to supply goods and services online and process electronic orders, several software components are used for operating a supplier processor server and a supplier catalog server. To enable corporate purchasers to purchase products and services online, preferably over the Internet, from suppliers, software is used for operating a customer server to which multiple users may log-on and access the supplier server. An Automated Clearing House (ACH) server may be used to interface with a bank's (ACH) systems. A service bureau that supplies the hardware and/or software components and assists to administer the system includes a transaction counter, which records transactions and charges the buyers and/or suppliers based on the number of purchase orders and/or invoices issued. Some sections of Barnes et al. of particular relevance include: Abstract; col. 3 line 5 – col. 4 line 26; col. 6 line 5 – col. 9 line 13.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 7-8, 16-17, 21-22, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes et al. (U.S. Patent No. 5,970,475) and further in view of Burkes et al. (U.S. Patent No. 5,644,778).

Claims 7, 8, 16, 17, 21, 22, 29, 30: Additionally, Barnes et al. also does not explicitly disclose data pertaining to insurance. Barnes et al. does disclose suppliers, purchasers, an automated clearinghouse server, and a service bureau. However, Burks et al. discloses aspects of applicant's claimed invention in the context of a medical transaction system which is capable of permitting a plurality of healthcare providers to communicate a variety of types of information with a plurality of payors and financial institutions (i.e., a plurality of trading partners, e.g., including insurance processors), and, therefore, is analogous prior art and encompasses the aspect of providing transaction services between a variety of trading partner types. Additionally, Burks et al. discloses that the healthcare providers, payors, and financial institutions do not have to communicate in the same data message formats nor in the same communication

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protocols. Such a system facilitates not only the processing of medical claims submitted by the healthcare providers to the payors, but also permits the transfer of medical data records between healthcare providers. The system supports the processing of medical claims without requiring a centralized database or imposing a uniform claim format on the healthcare providers and payors. Some sections of Burks et al. of particular relevance include: Abstract; and col. 3 line 1 – col. 6 line 23. It would have been obvious to one skilled in the art at the time the invention was made to include the ability of sending transactions to a plurality of trading partners that encompass any trading provider necessary to process the purchasers' transactions.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the system and method of Barnes et al. to explicitly process data pertaining to purchaser/customer requests (e.g., data pertaining to insurance) in a compatible format, as disclosed by Burks et al., for the motivation of exchanging information between at least two trading partners engaged in a transaction, regardless of whether the transaction pertains to automobiles, medical treatments or goods/services.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art includes:

- Friend et al. (U.S. Patent Application Publication No. US 2001/0032165) that teaches the preparation and use of transaction offer notices by participating entities

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stored in a database over the Internet. Users are able to search the database for transaction offer notices that satisfy a set for search criteria, and are able to electronically negotiate with the offeror with respect to transaction parameters and other terms and conditions until the transaction is acceptable to both parties.

- Reisman (U.S. Patent No. 6,594,692) that teaches a novel electronic information transport component that can be incorporated in a wide range of electronic information products, for example magazine collections, to automate the mass distribution of updates, such as current issues, from a remote server to a wide user base having a diversity of computer stations. Advantages of economy, immediacy and ease of use are provided. Extensions of the invention permit automated electronic catalog shopping with order placement and, optionally, order confirmation. A server-based update distribution service is also provided.

- O'Neill et al. (U.S. Patent No. 6,219,653) that teaches a freight calculation system that includes a seller client, a buyer client, and a platform coupled to the seller client and the buyer client using a communication network. The seller client generates freight data and communicates it using a communication network. The buyer client communicates a delivery request for a load using the communication network. The delivery request specifies one of a number of delivery containers, an origination location, and a destination location. The platform receives and stores the freight data and determines a delivery cost for the load using the freight data, the specified delivery container, the origination location, and the destination location.

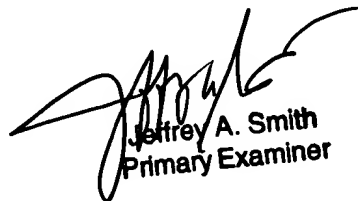
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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

FT   
08 December 2003

  
Jeffrey A. Smith  
Primary Examiner